

1 REMARKS

2 Status of the Claims

3 Claims 1-27 remain pending in the application. No amendment has been made to the  
4 application or the claims. This Request for Reconsideration is being submitted with a Request for  
5 Continued Examination (RCE), to traverse the final rejection of the claims in this application.

6 Claims Rejected under 35 U.S.C. § 103(a)

7 In the Final Office Action, the Examiner has rejected Claims 1-27 as being unpatentable over  
8 Buxton et al. (U.S. Patent No. 6,469,714, hereinafter "Buxton") in view of Hamilton et al. (U.S.  
9 Patent No. 5,991,534, hereinafter "Hamilton") in view of Grossman et al. (U.S. Patent  
10 No. 5,852,440), hereinafter "Grossman"). Applicants respectfully disagree with the rejection for the  
11 reasons discussed below.

12 In the interest of reducing the complexity of the issues for the Examiner to consider in this  
13 response, the following discussion focuses on independent Claims 1, 14, and 27. The patentability of  
14 each remaining dependent claim is not necessarily separately addressed in detail. However, applicants'  
15 decision not to discuss the differences between the cited art and each dependent claim should not be  
16 considered as an admission that applicants concur with the Examiner's conclusion that these dependent  
17 claims are not patentable over the disclosure in the cited references. Similarly, applicants' decision not to  
18 discuss differences between the prior art and every claim element, or every comment made by the  
19 Examiner, should not be considered as an admission that applicants concur with the Examiner's  
20 interpretation and assertions regarding those claims. Indeed, applicants believe that all of the dependent  
21 claims patentably distinguish over the references cited. However, a specific traverse of the rejection of  
22 each dependent claim is not required, since dependent claims are patentable for at least the same reasons  
23 as the independent claims from which the dependent claims ultimately depend.

24 Discussion of the Rejection of Independent Claim 1

25 With respect to independent Claim 1, the Examiner asserts that although Buxton fails to teach  
26 a portion of the second part of applicants' third step (i.e., that an activated associated content of the  
27 palette does not obscure viewing the electronic document), that Hamilton teaches this step, as shown  
28 in FIGURE 4B, Item 434). The Examiner asserts that it would have been obvious to an artisan at the  
29 time of the invention to include Hamilton's teaching with the method of Buxton in order to reduce the  
30 potential for error.

1           However, significant differences exist between Hamilton and the first part of the third step of  
2 applicants' Claim 1, which recites "displaying the palette in conjunction with the electronic document  
3 on the user interface such that said palette and *an activated associated content of the palette do not*  
4 *obscure viewing of said electronic document*," because Hamilton does not teach or disclose the  
5 recited elements of (1) "an activated associated content;" (2) or that the activated content is  
6 associated with the palette; and, (3) that there is no obscuring of the electronic document.

7           The Examiner has cited Figure 4b and item 434 of Hamilton. Figure 4b is a diagrammatic  
8 representation of the property sheet of FIGURE 4a with an associated property editor in accordance  
9 with an embodiment of the present invention (Hamilton, column 3, lines 26-28) and item 434 is a  
10 property editor (Hamilton, column 7, line 56). The Examiner has not explained which elements  
11 included in FIGURE 4b he believes are equivalent to applicants' recited claim elements. But  
12 Hamilton discloses that a property sheet 404 is displayed to a user, on a display medium 408 as  
13 shown in FIGURE 4a (Hamilton, column 7, lines 36-40). In addition, property sheet 404 is shown as  
14 including the example of font 412. (Hamilton, column 7, lines 44-46). Furthermore, when the  
15 example of font 412 in property sheet 404 is selected by a user, a property editor 434 that may be  
16 used to modify properties of font 412 is displayed. The property editor is a dialog box and includes  
17 selectable choices for a font type 440, a font size 444, etc. (Hamilton, column 7, lines 56-60).  
18 Assuming, *arguendo*, that the Examiner is implying that item 434, the property editor, is activated  
19 associated content of the property sheet as shown in FIGURE 4b, and thus, might be equivalent to  
20 applicants' activated associated content of the palette, there is still no teaching or suggestion in  
21 Hamilton that the property editor and the property sheet *do not obscure an electronic document*.  
22 Note that Figure 4b shows an electronic document. Item 408 is a display medium (Hamilton,  
23 column 7, lines 39-40), not an electronic document. Thus, Hamilton does not teach or suggest "...*an*  
24 *activated associated content of the palette does not obscure viewing of said electronic document*."

25           Second, the Examiner asserts that although both Buxton and Hamilton fail to teach the first  
26 part of applicants' third step (i.e., display only the controls that are available), that Grossman teaches  
27 display only the icons that are active as shown in column 9, lines 60-66. Thus, the Examiner asserts  
28 that it would have been obvious to an artisan at the time this application was filed to combine  
29 Grossman's teaching with the method of Buxton and Hamilton in order to increase system resource  
30 or space on the user's desktop.

1 However, significant differences exist between Grossman and applicants' second part of the  
2 third step, which recites "creating a customized palette for the user interface *so that the palette*  
3 *comprises a control only for an available property*" because applicants' criteria for including a  
4 control is different from Grossman's criteria for including an icon. Applicants claim only includes  
5 the control if the property is available, while Grossman appears to include the icon based on criteria  
6 involving the likeliness of icon usage and/or inactivity of icon usage. However, the likeliness of the  
7 icon usage or inactivity of icon usage does not imply or suggest that a functionality of the icon is  
8 available.

9 Applicants claim that the palette only comprises a control for an available property. Thus, in  
10 the recitation of applicants' claims, the criteria for what the palette includes is based on whether a  
11 particular property is available. If the property is available, a control is included, and otherwise, the  
12 control is not included.

13 In contrast, in Grossman, the criteria for what a screen display includes is based on whether a  
14 particular icon is likely to be used. If the icon is likely to be used, the Abstract of Grossman teaches  
15 that the icon is less likely to be faded, eliminated or shrunk to a smaller size. Furthermore, Grossman  
16 teaches that icons, which are not used may disappear into a master icon, and icons which have a  
17 conceptual relationship between them may be linked by a visual graphical representation.

18 Grossman discloses (with the portion cited by the Examiner in bold):

19 In a further effort to clean up a computer display or a messy desk top, a  
20 technique is provided wherein the visual clutter is reduced by gradually  
21 removing those elements from the display which have not been recently used,  
22 and optionally, closing the associated computer sessions in order to reduce the  
23 processor load. As described below, in accordance with the principles of the  
24 present invention, desk top elements, such as icons, which have not been used  
25 for some time or with a low expected probability of use have a gradual change  
26 in their appearance. As examples, they may grow hazy or fade into the  
27 background, their actual dimensions may be changed so that they shrink until  
28 they disappear or they shrink along one dimension appearing to be squashed,  
29 they move or drift to the edge of the display or they have an intensity border  
30 which grows along the perimeters of the **icons the longer the icons have been**  
**inactive. With the intensity border, in a further example, once the border is**  
**complete, the icon is considered unused beyond a predefined time-out limit**  
**and it is removed from the screen. Selecting the icon would reset the**  
**intensity border. For instance, a 3600 pixel border could have one pixel**  
**illuminated every one second. At the end of one hour, for this example, the**

1 icon's intensity border would be complete and the inactive icon would be  
2 removed to free system resources, such as, for example, an OS/2 thread  
3 (Emphasis added, Grossman, column 9, lines 45-column 10, line 2).

4 So it appears that Grossman does not teach or suggest criteria for displaying only icons that  
5 are available, but instead teaches criteria for a display based on icon activity or inactivity. Thus,  
6 icons that have not have been used for a while (indicating inactivity) are, for example, gradually  
7 faded away. Accordingly, Grossman does not teach or suggest the applicants' claimed recitation  
8 "that the palette comprises a control only for an available property."

9 Accordingly, the rejection of independent Claim 1 under 35 U.S.C. § 103(a) over Buxton in  
10 view of Hamilton and further in view of Grossman should be withdrawn. Because dependent claims  
11 include all of the elements of the independent claims from which the dependent claims ultimately  
12 depend, and because Buxton in view of Hamilton and further in view of Grossman does not disclose  
13 or suggest all of the elements of independent Claim 1, the rejection of dependent Claims 2-13 under  
14 35 U.S.C. § 103(a) over Buxton in view of Hamilton and further in view of Grossman should be  
15 withdrawn for at least the same reasons as the rejection of Claim 1.

16 Discussion of the Rejection of Independent Claim 14

17 With regard to independent Claim 14, the Examiner asserts that it is of similar scope to  
18 Claim 1, respectively, and thus is rejected under the same rationale. Claim 14 is directed to a  
19 computer system for providing a selection of formatting properties for an electronic document  
20 associated with an application program having a user interface. For the same reasons already noted  
21 in regard to Claim 1, Claim 14 also distinguishes over Buxton in view of Grossman and further in  
22 view of Hamilton. Accordingly, the rejection of independent Claim 14 under 35 U.S.C. § 103(a)  
23 over Buxton in view of Hamilton and further in view of Grossman should be withdrawn. Because  
24 dependent claims inherently include all of the elements of the independent claims from which the  
25 dependent claims ultimately depend, and because Buxton in view of Hamilton and further in view  
26 of Grossman does not disclose or suggest all of the elements of independent Claim 14, the rejection  
27 of dependent Claims 15-26 under 35 U.S.C. § 103(a) over Buxton in view of Hamilton and further  
28 in view of Grossman should be withdrawn for at least the same reasons as the rejection of  
29 Claim 14.

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1 Discussion of the Rejection of Independent Claim 27

2 With regard to amended independent Claim 27, the Examiner asserts that it is rejected under  
3 the same rationale as Claims 1, 2, 3, 4, and 9. Claim 27 is directed towards a computer system for  
4 providing a selection of formatting properties for an electronic document associated with an  
5 application program having a user interface. However, for the same reasons already noted in regard  
6 to Claim 1, Claim 27 also distinguishes over Buxton in view of Grossman and further in view of  
7 Hamilton. Accordingly, the rejection of independent Claim 27 under 35 U.S.C. § 103(a) over Buxton  
8 and further in view of Hamilton and Grossman should be withdrawn.

9 In view of the amendments and Remarks set forth above, it will be apparent that the claims in  
10 this application define a novel and non-obvious invention, and that the application is in condition for  
11 allowance and should be passed to issue without further delay. Should any further questions remain,  
12 the Examiner is invited to telephone applicants' attorney at the number listed below.

13 Respectfully submitted,

14 

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17 SKM/RMA:klp

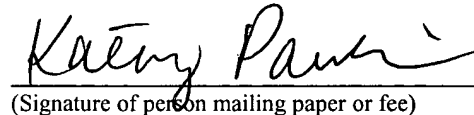
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